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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,340	01/31/2001	John T. McDevitt	5119-00524EBM:	7212

7590 10/25/2002
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EXAMINER

LY, CHEYNE D

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 10/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,340

Applicant(s)

MCDEVITT ET AL.

Examiner

Cheyne D Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 309-343 and 375 is/are pending in the application.
- 4a) Of the above claim(s) 325-342 and 375 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 309-324 and 343 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 309-343 and 375 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Applicant's election without traversal of Group I, Species I-B (Non-sensor array detection), claims 309-324 and 343, in Paper No. 10, filed September 3, 2002, is acknowledged.
2. Claims 309-324 and 343 are examined on the merits.

Information Disclosure Statement

3. The information disclosure statement filed April 23, 2002 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the publication Ref. Des. D50 does not contain the publication date for the listed reference. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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5. Claims 309-313, 317, 318, 322-324 and 343 are rejected under 35 U.S.C. 102(e)(2) as being clearly anticipated by Buechler et al. (P/N US 6,074,616).
6. The above U.S. Patent (P/N US 6,074,616) discloses a method of collecting and transmitting over a computer network to a client computer chemical information from an analyte detection device. Buechler et al. discloses the use of an assay device in conjunction with the fluorometer, a single detector, to achieve a result regarding the concentration or presence of an analyte in a sample. This assay device includes a light source, detector and optics used to excite the sample as well as to sense the fluorescence of the excited sample (Column 3, Lines 43-46). Further, the fluorometer can be operated as a portable hand-carried piece of test equipment that is used to test samples of blood. The portable, hand-carried unit can then be interfaced to a computer or computer network to upload test results or to simply communicate other data associated with the test and to use the processing power of the computer or computer network to perform some or all of the actual test processing (Column 4, Lines 12-28). Buechler et al. clearly anticipates the method of collecting and transmitting over a computer network to a client computer chemical information from an analyte detection device. As disclosed by the Applicant, a computer system is described as the hardware and software components that in combination allow the execution of computer programs (Page 128, Lines 24-25). Further, a client computer is one that is connected to a network (Page 131, Line 25). Buechler et al. discloses a computer system that comprises of a processor, a user interface, a memory, a communications interface, an assay device, a storage device, and a removable storage device (Column 6, Lines 22-27). Further, this computer system is connected to computer network that has multiple devices, e.g. client computer and printer, connected to it (Figure 4). As mentioned above, the assay device

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communicates with the computer system or computer network that has a client computer connected to it for the transmission test results.

7. Buechler et al. discloses a communications interface that can include a wired and wireless interface to provide direct or networked communications. The communications interface between the fluorometer and the assay device can be used to download test data sets, including, for example, test identifications, test instructions and calibration curves, as well as other program information and calibration and control information. The communications interface can also be used to allow the fluorometer to share processing responsibilities with other devices such as a computer or other processor (Column 2, Lines 33-40). By sharing program test data, calibration and control information across a network between the assay device and a client computer or other devices, Buechler et al. further anticipates the limitations of transmitting information and controlling the operation via program information between an analyte detection device and local computer or client computer via the computer network.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 314-316 and 319-321 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buechler et al. (P/N US 6,074,616) taken with Bowman-Amuah et al. (P/N US 6,332,163 B1). Further, the embodiments of Claims 314-316 and 319-321 are deemed species within the generic Claim 309; therefore, the 103(a) rejection is directed to all instant claims 309-324 and 343 which are under examination.

11. Buechler et al. discloses a method of collecting and transmitting over a computer network to a client computer chemical information from an analyte detection device. However, Buechler et al. does not teach a method of collecting and transmitting over a computer network that comprises a server, web server, a web site, displaying data on a website, an intranet, extranet, or local area network to a client computer chemical information from an analyte detection device. Bowman-Amuah et al. teaches a method for providing communication services over a computer network system. The method of Bowman-Amuah et al. comprises multiple interfaces to an application including a handheld device, a desktop PC, and a telecommunications device (FIG. 124). Bowman-Amuah et al. discloses a client computer communicates with a server over a network (Column 246, Lines 32-33). The network may be at least one of a local area network and a wide area (Column 246, Lines 26-27). Web browsers reside in clients and Web documents reside in servers. Web clients and Web servers communicate using a protocol called "HyperText Transfer Protocol" (HTTP) (Column 1, Lines 61-64). Information is stored on a server (Column

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103, Lines 38-39). This information or "applets" can be downloaded onto a Web browser (Column 100, Lines 38-40) that resides in a client computer. A website is essentially comprised of web documents that are navigational via HTTP links. This includes stand-alone Java applications as well as "applets" that are downloaded and run in Web browsers. Further, Bowman-Amuah discloses delivering applications to a wide variety of users over the Internet, intranet, and extranet (Figure 28 and Column 108, Lines 29-31). Clearly, a skilled artisan would have been motivated to partake the concept emphasized by Buechler et al. for facilitating communications between the fluorometer and one or more other devices (Column 2, Lines 29-31) as a means of collecting and transmitting chemical information from an assay device via a computer network by adding improved communications capabilities. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to add improved communications capabilities via a web server, web site or greater network availability via the intranet, extranet or LAN as taught by Bowman-Amuah et al.

INDEFINITENESS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

13. Claims 309-324 are rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

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14. Specific to Claim 309, the phrase "comprises is configured" (Lines 6-7) renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. Claims 310-324 are rejected for being dependent from Claim 309. See MPEP § 2173.05(d).

15. No claim is allowed.

16. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (703) 308-3880. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

19. Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

C. Dune Ly
10/22/02

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER